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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Donald S. Dowden

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Serial No. 75/714,606

Donald S. Dowden of Cooper & Dunham LLP for Donald S. Dowden.

Caroline E. Wood, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Simms, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark US PATENT LAW REPORT (in typed form) for goods identified in the application as "a periodical, namely, a newsletter in the field of intellectual property."<sup>1</sup>

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<sup>1</sup> Serial No. 75/714,606, filed May 27, 1999. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Applicant has disclaimed the exclusive right to use US PATENT LAW apart from the mark as shown.

The Trademark Examining Attorney has issued final refusals of registration on two separate grounds. First, she contends that applicant's mark is merely descriptive of the goods and thus is unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Second, she contends that the mark is primarily geographically descriptive and thus is unregistrable under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2).

Applicant has appealed both final refusals.<sup>2</sup> The appeal has been fully briefed, but no oral hearing was requested. After careful consideration of the evidence and arguments submitted by counsel, and for the reasons discussed below, we affirm the Section 2(e)(1) mere descriptiveness refusal, but we reverse the Section 2(e)(2) geographic refusal.

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<sup>2</sup> The application initially came to the Board on applicant's appeal of the Trademark Examining Attorney's final Section 2(e)(2) geographic refusal. After reviewing the appeal briefs pertaining to that refusal, the Board, pursuant to Trademark Rule 2.142(f)(1), 37 C.F.R. §2.142(f)(1), remanded the application to the Trademark Examining Attorney for consideration of whether a Section 2(e)(1) mere descriptiveness refusal should be issued. The Trademark Examining Attorney then issued such refusal, and eventually made the refusal final. Applicant and the Trademark Examining Attorney have filed supplemental briefs directed to the Section 2(e)(1) refusal.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used (or will be used) on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Finally, "[w]hether consumers could guess

what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corporation*, 226 USPQ 365, 366 (TTAB 1985).

Applying these principles in the present case, we find that applicant's mark US PATENT LAW REPORT is merely descriptive of the goods identified in the application, i.e., "a periodical, namely, a newsletter in the field of intellectual property." The mark directly and immediately informs purchasers that applicant's newsletter comprises, provides or features a report on issues pertaining to the subject of U.S. patent law.

Based on the Trademark Examining Attorney's dictionary evidence, we find the term "US" in the mark is and would be understood to be the equivalent of "U.S." and "United States." We also find that PATENT LAW is the name of a field or body of law within the more general field known as "intellectual property." Taking the terms together, we find that US PATENT LAW readily would be perceived as the equivalent of "U.S. patent law" or "United States patent law," and that it readily would be understood to refer to the body of constitutional, statutory, regulatory,

decisional and other authorities which make up the patent law of the United States.<sup>3</sup>

Where the goods in an application comprise a publication (such as the periodical newsletter identified in applicant's application), wording in the mark which merely describes the subject matter of the publication is

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<sup>3</sup> A cursory review of reported cases reveals that the term "U.S. patent law" or its equivalent "United States patent law" often is used descriptively or generically in court opinions to refer to this field or area of the law. See, e.g., *Bayer AG v. Carlsbad Technology Inc.*, 298 F.3d 1377, 64 USPQ2d 1045, 1046 (Fed. Cir. 2002)("In 1994, the URAA harmonized the term provision of United States patent law with that of our leading trading partners..."); *International Nutrition Co. v. Horphag Research Ltd.*, 257 F.3d 1324, 59 USPQ2d 1532, 1535 (Fed. Cir. 2001)("INC argues that the ownership of a United States patent is a matter of United States patent law..."); *U.S. Valves Inc. v. Dray*, 190 F.3d 811, 52 USPQ2d 1055, 1058 (7<sup>th</sup> Cir. 1999)("Because U.S. Valves' claim for breach of contract involves patent infringement claims, and therefore necessarily requires application of U.S. patent law, the Federal Circuit has jurisdiction over this appeal..."); *Viam Corp. v. Iowa Export-Import Trading Co.*, 84 F.3d 424, 38 USPQ2d 1833, 1837 (Fed. Cir. 1996)("... subjecting their patents to the rigorous scrutiny demanded by United States patent law"); *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 34 USPQ2d 1565, 1570 (Fed. Cir. 1995)("That Glaxo thought it may have a best mode problem either because of its incorrect or incomplete consideration of U.S. patent law does not make it so"); *Mars Inc. v. Kabushiki Kaisha Nippon Conlux*, 24 F.3d 1368, 30 USPQ2d 1621, 1624 (Fed. Cir. 1994)("Moreover, Section 1338(b) itself sets a claim of unfair competition apart from a claim arising under U.S. patent law"); *Kronos Inc. v. AVX Corp.*, 23 USPQ2d 1792, 1793 (DC WNY 1992)("It is a long standing principle of U.S. patent law that in the event of a complete assignment of title to a patent..."); *Hitachi Metals Ltd. v. Quigg*, 20 USPQ2d 1920, 1924 (DC DC 1991)("... inconsistent with the administrative scheme designed to implement U.S. patent law..."); and *Quantum Corp. v. Sony Corp.*, 16 USPQ2d 1447, 1449 (DC NCalif. 1990)("Defendants' argument that plaintiffs have no cognizable right under U.S. patent law does not go to the Court's subject matter jurisdiction over the plaintiffs' claims, but rather to the merits of those claims").

deemed to be merely descriptive of the publication as well, since it merely describes a feature or characteristic of the goods. See, e.g., *In re Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972)(CREDIT CARD MARKETING); *In re Nippon Kokan Kabushiki Kaisha*, 171 USPQ 63 (TTAB 1971)(JAPAN STEEL NOTES); and *In re Medical Digest, Inc.*, 148 USPQ 570 (TTAB 1965)(OB/GYN DIGEST). We find that US PATENT LAW is merely descriptive of applicant's publication, because it merely describes the subject matter of the publication, i.e., U.S. patent law. The term immediately and directly informs purchasers that the publication provides or features content which pertains to the subject of U.S. patent law. We have carefully considered applicant's arguments in support of his contention that this wording is not merely descriptive, but we find them to be wholly unpersuasive.<sup>4</sup>

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<sup>4</sup> Because applicant submitted his disclaimer of US PATENT LAW voluntarily in an attempt to overcome the Trademark Examining Attorney's Section 2(e)(2) geographic refusal, we do not deem the disclaimer to be a concession by applicant of the mere descriptiveness of the term which would preclude consideration of applicant's arguments to the contrary. Cf. *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, n.4 (TTAB 1988); *In re Ampco Foods, Inc.*, 227 USPQ 31 (TTAB 1985). Applicant's arguments are not persuasive in any event, however. For example, it is not material that the application is based on intent-to-use and that we therefore cannot say with certainty at this time what the subject matter of the actual newsletter will be; we must presume that applicant's newsletter is or will be a newsletter about U.S. patent law, because such a newsletter is encompassed within applicant's identification of goods. Likewise, the mere descriptiveness of US PATENT LAW is not negated by the fact that

We also find that REPORT is merely descriptive as applied to the goods. The term directly and immediately informs purchasers that applicant's periodical newsletter reports on issues involving U.S. patent law. REPORT is commonly used as a descriptive or generic term in titles of newsletters or other publications, and it would be perceived as such in applicant's mark as well. The Trademark Examining Attorney has submitted numerous third-party registrations in which REPORT has been acknowledged or found to be not inherently distinctive when it appears in a mark for a publication.<sup>5</sup> These registrations are evidence of the descriptive meaning and significance that is and would be accorded to the term. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1978); *Cutter Laboratories, Inc. v. Air Products & Chemicals, Inc.*, 189 USPQ 108 (TTAB 1975). Finally, we note that the mere descriptiveness of REPORT as applied to

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the term does not encompass all aspects of "the field of intellectual property," nor by the fact that the term does not name or describe all possible sub-topics or issues within the field of U.S. patent law.

<sup>5</sup> Additionally, most if not all of the third-party registrations of marks which include the word REPORT, submitted by applicant as evidence in rebuttal to the mere descriptiveness refusal, instead support the opposite conclusion, i.e., that the term is merely descriptive. These registrations for publication titles either were issued pursuant to the acquired distinctiveness provisions of Section 2(f), or they include a disclaimer of the word REPORT.

a periodical publication has been noted in at least one prior reported decision by the Board, i.e., *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983)(SAN DIEGO PADRES REPORT and PADRES REPORT merely descriptive of "periodic newsletter directed primarily to sports").<sup>6</sup>

Applicant, in his brief, concedes that REPORT "can of course be applied to a newsletter," but argues that the term is not merely descriptive because "it can also be applied to a one-time production of, say, a Congressional committee, or a bar association." (Supplemental brief at 4.) However, the fact that REPORT also might be merely descriptive of publications other than newsletters is irrelevant, and it does not negate the mere descriptiveness of the word as applied to newsletters, which are the goods identified in applicant's application. Applicant has provided no persuasive explanation or argument as to why REPORT is not merely descriptive as applied to a newsletter.

In summary, we find that US PATENT LAW merely describes the subject matter of the newsletter, and REPORT

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<sup>6</sup> The Board recently overruled this case on grounds not related to the mere descriptiveness of the term REPORT. See *In re WNBA Enterprises, LLC*, \_\_\_ USPQ2d \_\_\_, Serial No. 75/599,525 (TTAB June 11, 2003).



is merely descriptive of newsletters in general and applicant's newsletter in particular. Combining US PATENT LAW and REPORT does not negate the mere descriptiveness of either, nor does it result in a composite which itself is inherently distinctive. Viewed in its entirety, US PATENT LAW REPORT is merely descriptive of the goods identified in the application. Accordingly, we affirm the Section 2(e)(1) mere descriptiveness refusal.

However, we reverse the Trademark Examining Attorney's Section 2(e)(2) "primarily geographically descriptive" refusal. For the reasons discussed above, we find that the primary significance of the term "US" as it appears in applicant's mark is not as an indication of the geographic origin of the newsletters, but rather as the name of the jurisdiction or type of "patent law" which comprises the subject matter of the publication. In applicant's mark, "US" would be perceived as modifying PATENT LAW, not as the geographic origin of a PATENT LAW REPORT. See, e.g., *Hamilton-Brown Shoe Co v. Wolf Brothers & Co.*, 240 U.S. 251 (1916)(AMERICAN GIRL not geographically descriptive); *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999)(SYDNEY 2000 not geographically descriptive).

**Decision:** The Section 2(e)(2) refusal is reversed, but the Section 2(e)(1) refusal is affirmed.